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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,238	12/05/2001	James G. Shanahan	D/A1320	8310

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EXAMINER

RIES, LAURIE ANNE

ART UNIT PAPER NUMBER

2176

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/683,238	Applicant(s) SHANAHAN ET AL.	
	Examiner Laurie Ries	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/11/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 11-12, 16, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horowitz (U.S. Patent 6,122,647) in view of Spellman (U.S. Patent 6,667,747 B1).

As per claim 1, Horowitz discloses a system for enriching (or annotating with a predefined theme) the content of a document using personalities that identify enrichment themes with at least one tag located close to a physical identifier that is associated with a personality (or theme) in a database of personalities (or themes), and a method including recording context information, identifying document content using the recorded context information, enriching the identified document content with the personality, and making the enriched document content available (See Horowitz, Column 5, lines 60-64, Figure 7, Column 8, lines 38-67, Column 9, lines 1-63, Figure 8, Column 10, lines 8-27 and Column 11, lines 39-40). Horowitz does not disclose expressly including a personality ID located close to the physical object that is associated with the recorded context information. Spellman discloses using a topic ID to relate context information to a tag (See Spellman, Figure 13, and Column 13, lines 23-28). Horowitz and Spellman are analogous art because they are from the same field

of endeavor of linking hypertext data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the topic ID of Spellman with the method of Horowitz. The motivation for doing so would have been to enable a grouping of topics according to the document to which they correspond (See Spellman, Column 13, lines 39-46). Therefore, it would have been obvious to combine Spellman with Horowitz for the benefit of grouping the topics to the corresponding documents to obtain the invention as specified in claim 1.

As per claim 2, Horowitz and Spellman disclose the limitations of claim 1 as described above. Horowitz also discloses transmitting the recorded personality ID and the context information to a meta-document server, where the meta-document server identifies the document content, associates the identified document content with the personality ID, and enriches the document content (See Horowitz, Figure 8, Figure 9, and Column 11, lines 24-32).

As per claim 3, Horowitz and Spellman disclose the limitations of claim 2 as described above. Horowitz also discloses that the meta-document server, upon identification of the document content, associates the personality ID with the identified document content (See Horowitz, Figure 8, element 808), that the meta-document server recognizes, with at least a first method, an entity in the document content (See Horowitz, Column 8, lines 50-61), that the meta-document server accesses, with at least a second method, a document service using the recognized entity (See Horowitz, Column 9, lines 28-63), that the meta-document server annotates the identified document content with output from the document service to define enriched document

content (See Horowitz, Figure 8, element 810, and Column 10, lines 22-27), and that the meta-document server makes the enriched document content available to a set of one or more users (See Horowitz, Column 11, lines 39-40).

As per claim 4, Horowitz and Spellman disclose the limitations of claim 1 as described above. Horowitz also discloses including recording the personality ID from the tag with a tag reader, where the encoding encodes the personality ID in an electronic tag (See Horowitz, Column 9, lines 13-26).

As per claims 11 and 19, Horowitz discloses a system for enriching (or annotating with a predefined theme) content of a document using personalities that identify enrichment themes including a tag located close to a physical object, a tag reader, and a meta-document server for receiving the recorded personality ID, associating the personality ID with the identified document content, enriching the identified document content with the personality identified by the personality ID, and making the enriched document content available (See Horowitz, Column 5, lines 60-64, Figure 7, Column 8, lines 38-67, Column 9, lines 1-63, Figure 8, Column 10, lines 8-27, and Column 11, lines 39-40). Horowitz does not disclose expressly a personality ID for identifying a personality in a database of personalities. Spellman discloses using a topic ID to relate context information to a tag (See Spellman, Figure 13, and Column 13, lines 23-28). Horowitz and Spellman are analogous art because they are from the same field of endeavor of linking hypertext data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the topic ID of Spellman with the method of Horowitz. The motivation for doing so would have been to

enable a grouping of topics according to the document to which they correspond (See Spellman, Column 13, lines 39-46). Therefore, it would have been obvious to combine Spellman with Horowitz for the benefit of grouping the topics to the corresponding documents to obtain the invention as specified in claims 11 and 19.

As per claim 12, Horowitz and Spellman disclose the limitations of claim 11 as described above. Horowitz also discloses that the tag reader is an electronic tag reader configured to read a digitally readable electronic tag (See Horowitz, Column 9, lines 13-26).

As per claim 16, Horowitz and Spellman disclose the limitations of claim 11 as described above. Horowitz also discloses that the tag reader records context information for identifying document content (See Horowitz, Column 9, lines 13-26).

Claims 5-7 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horowitz (U.S. Patent 6,122,647) in view of Spellman (U.S. Patent 6,667,747 B1) as applied to claims 1 and 11 above, and further in view of Levy (U.S. Publication 2002/0138456 A1).

As per claims 5-7 and 14-15, Horowitz and Spellman disclose the limitations of claims 1 and 11 as described above. Horowitz and Spellman do not disclose expressly that the personality ID is encoded in embedded data of a hardcopy document, that the personality ID is recorded with a mobile computing device, or that the mobile computing device is adapted to transmit document tokens with the personality ID to the meta-document server. Levy discloses the delivery of a hardcopy document as a download

transmitted to a handheld or portable computer (See Levy, Page 4, paragraph 0099). Levy, Horowitz and Spellman are analogous art because they are from the same field of endeavor of transmitting hypertext data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the hardcopy downloaded to a mobile computing device of Levy with the personality ID of Horowitz and Spellman. The motivation for doing so would have been to offer content to a user in different formats (See Levy, Page 4, paragraphs 0099 and 0108). Therefore, it would have been obvious to combine Levy with Horowitz and Spellman for the benefit of offering content to users in different formats to obtain the invention as specified in claims 5-7 and 14-15.

Claims 8-9, 17-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horowitz (U.S. Patent 6,122,647) in view of Spellman (U.S. Patent 6,667,747 B1) as applied to claims 1, 11, and 19 above, and further in view of Goodisman (U.S. Publication 2002/0069223 A1).

As per claims 8-9, 17-18, and 20, Horowitz and Spellman disclose the limitations of claims 1, 16 and 19 as described above. Horowitz and Spellman do not disclose expressly that the recorded context is one of time information including a timestamp, and position information including a position ID. Goodisman discloses including time and location information in context data (See Goodisman, Page 2, paragraph 0025). Horowitz, Spellman and Goodisman are analogous art because they are from the same field of endeavor of linking hypertext data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the time and position

information of Goodisman with the context data of Horowitz and Spellman. The motivation for doing so would have been to present different information to different users through context filtering (See Goodisman, Page 2, paragraph 0025). Therefore, it would have been obvious to combine Goodisman with Horowitz and Spellman for the benefit of presenting different information to different users through context filtering to obtain the invention as specified in claims 8-9, 17-18 and 20.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horowitz (U.S. Patent 6,122,647) in view of Spellman (U.S. Patent 6,667,747 B1) as applied to claim 11 above, and further in view of Hoover (U.S. Patent 6,753,977 B2).

As per claim 13, Horowitz and Spellman disclose the limitations of claim 11 as described above. Horowitz and Spellman do not disclose expressly that the tag reader is a scanner configured to read the embedded data. Hoover discloses a scanner configured to read embedded data (See Hoover, Column 6, lines 29-50). Hoover, Horowitz and Spellman are analogous art because they are from the same field of endeavor of processing electronic data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the scanner of Hoover with the tag reader of Horowitz and Spellman. The motivation for doing so would have been to provide input encoded data from a hardcopy to a processor (See Hoover, Column 6, lines 32-38). Therefore, it would have been obvious to combine Hoover with Horowitz and Spellman for the benefit of providing input encoded data from a hardcopy to a processor to obtain the invention as specified in claim 13.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horowitz (U.S. Patent 6,122,647) in view of Spellman (U.S. Patent 6,667,747 B1) as applied to claim 1 above, and further in view of Keith Jr (U.S. Publication 2002/0032672 A1).

As per claim 10, Horowitz and Spellman disclose the limitations of claim 1 as described above. Horowitz and Spellman do not disclose expressly providing notification that the enriched document is available. Keith Jr discloses notifying a user regarding updated data (See Keith Jr, Pages 10-11, paragraph 0092). Keith Jr, Horowitz and Spellman are analogous art because they are from the same field of endeavor of processing electronic data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the user notification of updated data of Keith Jr with the enriched document of Horowitz and Spellman. The motivation for doing so would have been to push information to users when desired new information is entered into the system (See Keith Jr, Page 11, paragraph 0092). Therefore, it would have been obvious to combine Keith Jr with Horowitz and Spellman for the benefit of pushing information to users when desired new information is entered into the system to obtain the invention as specified in claim 10.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Boguraev (U.S. Patent 6,184,492 B1) discloses summarizing text documents by resolving co-referentiality among actors or objects around which a story unfolds.
- Copperman (U.S. Patent 6,711,585 B1) discloses a system and method for implementing a knowledge management system.
- Rooke (U.S. Publication 2002/0065673 A1) discloses a business intelligence system.
- Denesuk (U.S. Publication 2003/0212649 A1) discloses a knowledge-based data mining system.
- Leymann (U.S. Publication 2002/0026297 A1) discloses taxonomy generation support for workflow management systems.
- Schneiderman (U.S. Publication 2002/0054059 A1) discloses methods for the electronic annotation, retrieval, and use of electronic images.
- Sundaresan (U.S. Patent 6,651,058 B1) discloses a system and method of automatic discovery of terms in a document that are relevant to a given target topic.
- Brush discloses robust annotation positioning in digital documents.
- Marshall discloses the development and use of hypertext annotation.

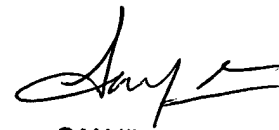
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095. The examiner can normally be reached on Monday-Friday from 7:00am to 3:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild, can be reached at (571) 272-4090.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LR



SANJIV SHAH
PRIMARY EXAMINER